

**REMARKS**

Claims 1-38 stand in this application. Favorable reconsideration and allowance of the standing claims are respectfully requested.

Claims 1-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 6,133,904 (Tzirkel-Hancock) in view of USPN 6,161,090 (Kanevsky). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the rejection.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to the MPEP, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Claims 1-38 define over the Tzirkel-Hancock reference and the Kanevsky reference whether taken alone or in combination. As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example.

Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to

teach or suggest every element recited in claims 1-38. For example, claims 1 and 27 recite “communicating said speech features over said voice channel.” As correctly noted in the Office Action, Tzirkel-Hancock fails to disclose this language. Office Action, Page 3. According to the Office Action, the missing language is disclosed by Kanevsky in figures 2-5, and column 6, lines 3-26. Applicant respectfully disagrees.

Applicant submits that Kanevsky fails to disclose the missing features of claims 1 and 27. At column 6, lines 3-26, Kanevsky states, in relevant part, that “server 22 submits the utterance of the user’s name and request to automatic speech recognizer (ASR) 28 via link 26 which decodes the utterance and submits the decoded name and request back to server 22.” As an initial matter, “the utterance of the user’s name” as stated in Kanevsky may arguably represent speech, but does not comprise “speech features” as recited in the claimed subject matter. Further, “link 26” as stated in Kanevsky does not comprise a “voice channel” as recited in the claimed subject matter. A “voice channel” is typically used for voice communications, such as found in a wireless or cellular communication system, for example. *See* Specification, Pages 2-4, for example. By way of contrast, it appears that “link 26” is a data link for server 22 to send a limited set of speech to ASR 28, where it is converted to text, and ASR 28 sends the text via link 26 to server 22. Therefore, it appears that “link 26” is not suited for voice communications. Consequently, Kanevsky fails to disclose at least the language of “communicating said speech features over said voice channel” as recited in the claimed subject matter. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claims 1 and 27.

Claims 12, 17, 23, 25 and 35 recite features similar to those recited in claims 1 and 27. Therefore, for reasons analogous to those presented with respect to claims 1 and 27, Applicant respectfully submits that claims 12, 17, 23, 25 and 35, are non-obvious over Tzirkel-Hancock and Kanevsky, whether taken alone or in combination. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to these claims.

Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Accordingly, removal of the obviousness rejection with respect to claims 2-11, 13-16, 18-22, 24, 26, 28-34 and 36-38 is respectfully requested. These claims also are non-obvious and patentable over Tzirkel-Hancock and Kanevsky, taken alone or in combination, at least on the basis of their dependency from claims 1, 12, 17, 23, 25, 27 and 35. Applicant, therefore, respectfully requests the removal of the obviousness rejection with respect to these dependent claims.

Claims 1-38 also are patentable and non-obvious over the Tzirkel-Hancock in view of Kanevsky, whether taken alone or in combination, because a rejection based on obviousness under 35 U.S.C. § 103(a) is improper without a motivation to combine the cited references. *See* MPEP § 2142, for example. Tzirkel-Hancock fails to discuss a “voice channel” in any context, let alone “communicating said speech features over said voice channel.” Therefore, Tzirkel-Hancock clearly fails to provide the proper motivation to make the combination alleged by the Office. Similarly, Kanevsky also fails to discuss “speech features” in any context, let alone for “communicating said speech features over said voice channel.” Therefore, Kanevsky clearly fails to provide the

Appl. No. 10/000,228  
Response Dated November 10, 2004  
Reply to Office Action of August 10, 2004

proper motivation to combine. Furthermore, the Office does not set forth a clear line of reasoning or suggestion as to why it would have been desirable for a person of ordinary skill in the art to make the alleged combination of Tzirkel-Hancock and Kanevsky to arrive at the subject matter of claims 1-38.

For at least the above reasons, Applicant submits that claims 1-38 recite novel features not shown by the cited references. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

It is believed that claims 1-38 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

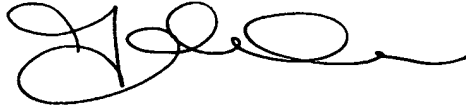
The Examiner is invited to contact the undersigned at 724-933-3387 to discuss any matter concerning this application.

Appl. No. 10/000,228  
Response Dated November 10, 2004  
Reply to Office Action of August 10, 2004

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.

Respectfully submitted,


BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP



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Under 37 CFR 1.34(a)

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Deborah L. Higham

11-10-04  
Date

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